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In re Application of
Van Saarloos et al.
Application No.: 09/831,971
PCT No.: PCT/AU99/01024
Int. Filing Date: 18 November 1999
Priority Date: 18 November 1998
Attorney's Docket No.: 8257.17USWO
For: LIMITED COHERENCE STEREO
OPHTHALMOSCOPE

DECISION ON

PETITION

UNDER 37 CFR 1.47(a)

This is a decision in response to the petition filed under 37 CFR 1.47(a) on 21 December 2001, to accept the application without the signature of co-inventor Dr. Paul Van Saarloos. The required \$130 petition fee was received with the petition.

BACKGROUND

On 25 March 1999, applicants filed international application PCT/AU99/01024, which claimed priority of an earlier Australian application filed 18 November 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau 25 May 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 14 May 2000. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 18 May 2001.

On 16 May 2001, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia, a copy of the international application, a copy of an Article 19 amendment, a copy of the Search Report, a copy of the International Preliminary Examination Report, a preliminary amendment and the requisite basic national fee as required by 35 U.S.C. 371(c).

On 21 June 2001, the United States Designated/Elected Office mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/EO/EO905), indicating that an oath or declaration and the surcharge for filing the oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) needed to be filed. The notification set a one-month time period in which to respond.

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On 21 December 2001, applicant filed a petition under 37 CFR 1.47(a). This petition included:

- 1) the petition fee required under 37 CFR 1.17(h);
- 2) the required surcharge for filing the declaration later than 30 months from the earliest priority date;
- 3) a declaration/power of attorney signed by inventor Fred Reinholz;
- 4) an affidavit by Jeanette Elizabeth Butler concluding that Dr. Van Saarloos would not sign a declaration and giving Dr. Van Saarloos' last known address; and,
- 5) a petition and fee for a five-month extension of time.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

With respect to item (1), the \$130 petition fee under 37 CFR 1.17(h) was included with the petition. The petition is missing item (2). With respect to item (3), Ms. Butler has given a statement of Dr. Van Saarloos' last known address. With respect to item (4) above, applicant has provided a declaration signed by Fred Reinholz.

MPEP 409.03(d) states, in part:

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted.

With respect to item (2) above, Ms. Butler has provided an affidavit stating that Clayton Utz sent a letter to Dr. Van Saarloos' legal counsel requesting that Dr. Van Saarloos execute the application papers. This information is hearsay, since Ms. Butler did not send the actual letter.

Further, before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings and oath or declaration) to the non-signing inventor for signature. Although Ms. Butler states that a complete set of application papers were provided to Dr. Van Saarloos' legal counsel with


the letter from Clayton Utz, Ms. Butler did not send the actual letter and the letter does not mention the application papers.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely submit the proper response will result in ABANDONMENT of the application.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C., 20231, with the contents of this letter marked to the attention of the PCT Legal Office



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